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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/690,755

10/22/2003

Barton E. Bennett

OTC0001

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10/23/2006

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EXAMINER

NGUYEN, HOA CAO

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



### **DETAILED ACTION**

1. The amendment filed on 8/8/06 has been entered. Applicant has amended claims 1, 6, and 10. Claims 21-30 are newly added.

2. Newly submitted claims 23-30 directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

(a) Claims (23-29) and claims (1-14 and 21-22) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require a heat sink or a heat sink lead for patentability. The subcombination has separate utility such as a heat sink.

(b) Claim (30) and claims (1-14, 21-29) are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the product as claimed in claims (1-14 and 21-29) cannot be made by the claimed process as claimed in claim (30).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-30 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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3. The newly added claims, claims 21-22, contain limitations such as a large structural composite structure and the core structure is porous that lead to interpretations toward different embodiments. In the previous Office Action, mailed on 4/5/06, the Examiner mentioned that the application contains claims directed to patentably distinct Species. The Examiner has assumed that the original claims, claims 1-14, lead to the embodiment shown in figures 2 and 3. However, the Examiner has to admit that the Office Action was unclear regarding the requirement on an election of Species.

Therefore, in order to make it clear and also due to the complexities of the claimed structures, an Election/Restrictions on Species is required.

***Election/Restrictions***

4. This application contains claims directed to the following patentably distinct species:

- Species 1: Figures 2-3, drawn to a structure of a first embodiment.
- Species 2: Figures 4-5, drawn to a structure of a second embodiment.
- Species 3: Figures 6-7, drawn to a structure of a third embodiment.
- Species 4: Figures 8-10, drawn to a structure of a fourth embodiment.
- Species 5: Figures 11-13, drawn to a structure of a fifth embodiment.
- Species 6: Figures 14-16, drawn to a structure of a sixth embodiment.
- Species 7: Figures 17-19, drawn to a structure of a seventh embodiment.
- Species 8: Figures 20-22, drawn to a structure of an eighth embodiment.
- Species 9: Figures 23-25, drawn to a structure of a ninth embodiment.

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Species 10: Figures 26-28, drawn to a structure of a tenth embodiment.

Species 11: Figures 29-30, drawn to a structure of a eleventh embodiment.

The species are independent or distinct because the details of the structure of each Species are different from each other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, figures 3-4 (the amended claims 1-14) are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa C. Nguyen whose telephone number is 571-272-8293. The examiner can normally be reached on M-F.

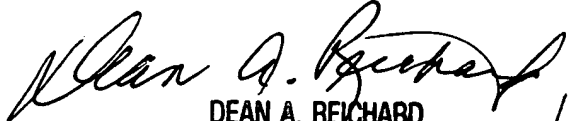
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reichard Dean can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hoa C. Nguyen  
9/3/06

  
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SUPERVISORY PATENT EXAMINER 10/16/06  
TECHNOLOGY CENTER 2800